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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,689	03/24/2000	Shigeo Suzuki	1232-4396US1	1838

7590 11/13/2002

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EXAMINER

BAYAT, BRADLEY B

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/534,689

Applicant(s)

SUZUKI, SHIGEO

Examiner

Bradley Bayat

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/978,072.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Claims 20-33 are presented for examination. Applicant has canceled claims 1-19, and new claims 20-33 have been added.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/978,072, filed on 11/25/97.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,061,452. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

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*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 20-33 in the application would have been obvious in view of claims 1-13 of U.S. Patent 6,061,452.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-23, 25-29, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Kubota et al., U.S Patent No. 5,787,171.

As per claim 20, Kubota et al. discloses a method of transmitting encoded data to a receiving side, and information concerning decoding of the encoded data (see column 2, lines 36-39 and figure 1, in the data transmitter of the present invention, data is transmitted after being scrambled, and simultaneously there is also transmitted an object which includes at least a descramble program prepared for descrambling the data).

As per claims 21 and 26, Kubota et al. discloses image and audio as one type of encoded data (see figure 1, video, audio).

As per claims 23 and 28, Kubota et al. discloses a symmetrical-key encoding method (see column 8, lines 42-48, when the data supplied to the processing circuit from the related data decoding circuit includes the scramble key used for scrambling the video signal from the

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television station, the processing circuit outputs such data to the decoder. Then the decoder descrambles, by using the scramble key as described...).

As per claim 25, Kubota et al. discloses a method of receiving encoded data from a transmitting side and decoding the encoded data using the obtained information for decoding (column 2, lines 44-47, meanwhile in the data receiver of the present invention, the scrambled data obtained from the data transmitter is received and descrambled in accordance with the scramble program).

As per claims 22 and 27, Kubota et al. discloses a method wherein the encoded data which has been encoded is the encoded data of which encoding method has been changed in a predetermined time unit (see column 2, lines 23-29, according to a further aspect of the present invention, there is provided a data receiver equipped with a compile means for compiling an intermediate code, which is included in a descramble program, into a predetermined machine code, and a descramble means for descrambling the scrambled data in accordance with a predetermined machine code; column 5, lines 26-30, accordingly, on the receiving side, the ciphered common data and individual data are deciphered by using a work key received already. Such work key is changed either periodically or nonperiodically. Changing the work key is controlled by a work control unit).

As per claims 29, Kubota et al. discloses that the requirement is based on the user's instructions to initiate decoding of the encoded data (column 4, lines 35-46; see figure 7, step 111).

As per claim 32, Kubota discloses a medium for storing in a computer readable state data concerning the transmitting of encoded data (see column 12, lines 62-63, a data source for storing predetermined data to be transmitted).

As per claim 33, Kubota discloses a medium for storing in a computer readable state data concerning the receiving of encoded data (see column 13, lines 64-65, memory means for storing the data descrambled by said descrambling means).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al, U.S. Patent 5,787,171 in view of Hayashi et al., U.S. Patent 4,759,060.

As per claim 24, Kubota et al. shows a data transmitter and receiver system for preventing illegal free tapping and utilization of a network (see abstract). Kubota et al. does not teach the use of a charging mechanism based on actual utilization of the encoded data. In addition to the conventional program or monthly subscription fee, Hayashi et al. teaches a fee system based on actual viewing or listening time (see column 4, lines 1-5; column 8, lines 16-21). Hayashi et al. further discloses that a more flexible and reasonable charging system is established to suit the user's interest by charging in units of time actually utilized (see column 8, lines 22-25). Hayashi et al. is evidence that one of ordinary skill in the art would recognize the benefit of an actual watching and listening fee. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify the conventional flat fee system (periodic subscription or program fee) to a more flexible actual listening and viewing fee, as per teachings of Hayashi et al.

As per claim 30, Kubota et al. discloses an embodiment wherein a timer function is included in the program and a periodical check for the terminal ID can be executed at a fixed time interval (see column 12, lines 18-21). Kubota et al., however, does not teach the use of various requirement checks to the transmitting side every predetermined unit time. Hayashi et al. teaches a continuously executed "check routine" to determine authorized use or whether to terminate use (see figures 5 and 6). Hayashi et al. is evidence that one of ordinary skill in the art would recognize the advantage and benefit of continuously issuing the requirement to the transmitting side until termination. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify any of these variables as part of the continuous requirement check, as per Hayashi et al.

As per claim 31, Kubota et al. discloses an embodiment wherein a timer function is included in the program and a periodical check for the terminal ID can be executed at a fixed time interval (see column 12, lines 18-21). Kubota et al., however, does not teach the use of a recording mechanism to determine actual utilization of data. Hayashi et al. teaches a fee system based on actual viewing or listening time deducted continuously from the user account (see column 4, lines 1-5; column 8, lines 16-21). Hayashi et al. accomplishes this by utilizing a signal from a timer which interrupts the normal control loop to check the balance maintained in the memory unit at periodic intervals, and record the data stored in the memory unit (column 6, lines 38-59). Hayashi et al. is evidence that one of ordinary skill in the art would recognize the



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benefit of periodically recording use of the encoded data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to periodically record any useful variables such as time and key changes for billing purposes, as per Hayashi et al.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Pitts et al. teaches a monitoring and reporting system for remote terminals.
- Crowther et al. teaches a system for decoding transmitted scrambled signals.
- Bestler et al. teaches a television signal scrambling system and method.
- Gammie teaches an external security module for a television signal decoder.
- Pires teaches a coding system for a data signal.
- Ueda teaches a video-on-demand system.
- Peterson teaches timed availability of secured content provisioned on a storage medium.
- Lee et al. teaches a security system for SSTV encryption.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached Tuesday thru Friday.

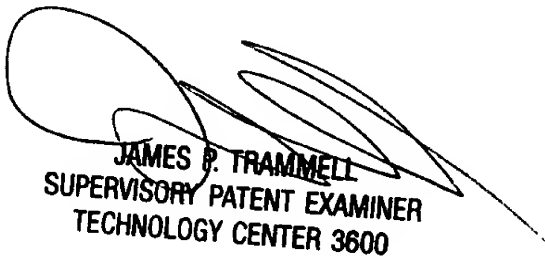
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6128 for regular communications and 703-746-6128 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb

October 30, 2002



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